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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/579,667	05/18/2006	Andre Ullrich	3627	5106
7590 Striker Striker & Stenby 103 East Neck Road Huntington, NY 11743				
			EXAMINER SMITH, SCOTT A	
			ART UNIT 3721	PAPER NUMBER
			MAIL DATE 09/15/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/579,667

Applicant(s)

ULLRICH ET AL.

Examiner

Scott A. Smith

Art Unit

3721

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 August 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 3-8 and 10-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3-8 and 10-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 8/27/08 has been entered.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1, 3-8 and 10-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims are replete with grammatical errors and should be rewritten since they are confusing and indefinite. The scope of the claims cannot be determined. For example, claim 1 recites a tool holder in the preamble, which is essentially elements 24, 22, but the body of the claim, and dependent claims therefrom recite details of the bit 10 and/or adapter 12. Therefore, it is unclear as to whether applicant intends to claim a holder, or a combination of a holder and plural interchangeable elements; i.e. the bit and adapter. Further, claim 8 recites an adapter in the preamble, which is essentially element 12, but the body of the claim, and dependent claims therefrom recite details of

the bit 10 and/or holder. Therefore, it is unclear as to whether applicant intends to claim an adapter, a bit, a holder, or a combination of a holder and plural interchangeable elements; i.e. the bit and adapter. In claim 8, line 7, "on" should be changed to "of" to alleviate grammatical errors. On line 7, "for centering" is claimed. What is centered in relation to the tool holder? Claim 3 is indefinite since "at least centering surface" is claimed on line 2. Claim 1 already claims the centering surface. Therefore, it is unclear as to whether claim 3 is claiming the same or a different centering surface. Similarly, claim 10 is indefinite since "at least centering surface" is claimed on line 2. Claim 8 already claims the centering surface. Therefore, it is unclear as to whether claim 10 is claiming the same or a different centering surface. Claim 8 recites an adapter to be used with the fitting of claim 1. This is improper. This "adapter" claim cannot properly depend from a "fitting" claim. Therefore, the scope cannot be determined. Claim 12 is worse, and the scope also cannot be determined. Some other examples of indefiniteness are as follows: In claim 1, line 3, the recitation of "by means of at least one means" is awkward. Dependent claims that recite "means" are indefinite since it is unclear as to which "means" in claim 1 is being referred to. Claim 12 is indefinite since "the means" on line 13 lacks proper antecedent basis. Which "means" is this referring to? Claim 12 as amended appears to be redundant in its plural claiming of "means" and "centering means", is grammatically awkward, and runs on absent positively claiming structure. Perhaps consideration should be given as to whether the desired invention is an adapter, a tool holder, or a kit combination of a bit, adapter, and holder.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1, 3-8 and 10-15 are rejected under 35 U.S.C. 102(b) as being anticipated by UK Patent Application '566, hereinafter GB '566.

GB '566 discloses the invention, as best understood from the claims, including a tool holder 21a having an end comprising for locating and centering the adapter or bit 15 therein, wherein the receiving aperture for the adapter has inclined or locking means; i.e. the ridges which cooperate with like shaped surfaces on the adapter/bit 15. It should be noted that the particulars of the bit, adapter, or system as claimed is given little if any patentable weight since the only independent claim 1 only recites a "tool holder" in the preamble. Further, GB '566 is capable of such intended use of the holder, if desired.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein

were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. Claims 1, 3-8 and 1-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over UK Patent Application '566, hereinafter GB '566.

In the event that GB '566 is interpreted not to disclose the invention as claimed; i.e. a bit/adaptor complementary in shape to the holder, it would have been obvious to form the bit/adaptor of GB '566 with a complementary shape as the end of the holder in order to more effectively mate the elements together. Further, to form the bit and adaptor as separate elements; i.e. a "kit" for example, would have been obvious to the skilled artisan concerned with changing tools for various applications.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott A. Smith whose telephone number is 571-272-4469. The examiner can normally be reached on 5:30-4:00 Tues.-Fri..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi Rada can be reached on 571-272-4467. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

S. Smith

/Scott A. Smith/
Primary Examiner, Art Unit 3721